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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,370	07/31/2000	Jason Sulak	18/05085742	5426

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EXAMINER

PILLAI, NAMITHA

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 07/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/629,370

Applicant(s)

SULAK ET AL.

Examiner

Namitha Pillai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 10-12 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U. S.

Patent No. 6,311,214 B1 (Rhoads).

Referring to claim 10, Rhoads discloses means for creating, modifying and printing of a printable product. Rhoads discloses using modifying a browser program, represented as the website, where in the client computer uses this website/browser to edit the defining data for the printable product. The Internet is the network used for accessing and displaying the data, wherein the web server contains the data and the web page displayed on the client's computer, accesses the information from the server, wherein this acquisition has downloaded data defining a printable product. Rhoads discloses modifying and customizing the information to print. See column 10, lines 51-56 and lines 24-26.

Referring to claims 11 and 12, Rhoads discloses modifying means for manipulating any of the design elements, wherein the elements include text or graphics for customizing the printable products (column 10, lines 18-20).

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 14-19 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads and U. S. Patent No. 5,742,768 (Gennmaro et al.).

Referring to claim 1, Rhoads discloses a system for the creation of printable products on-line. The on-line system is represented in an Internet network, which is made of a client and server. Rhoads discloses the online acquisition of a greeting card, which suggests a user through a client accessing information from a website which is presented to the user, the data that is stored in a server. Rhoads discloses presenting to the user, a variety of simple editing tools for customizing the greeting cards, thereby suggesting the server presenting data stored in the server that is data defining a plurality of printable products with design elements for modifying and assembling the product. Rhoads suggests with the website, a user accessing the server with a client for defining the data, wherein accessing the information through the website, suggests downloading the data to the client. Rhoads also suggests a printer operatively coupled with a client computer, wherein the printable product customized at a website, can be printed at the user's computer. See column 10, lines 51-56 and lines 24-26. Rhoads, discloses the use of accessing websites to create the customized the printable products, but does not discuss the details of this method, wherein a first program is downloaded to provide users with the modifying data for the printable products, as recited in the claims. Gennmaro discloses another website system with a server and clients, wherein a first program, represented as the applet is

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downloaded from the server to the client's computer, in order to display a menu wherein a user may manipulate or customize the web page based on their desires (column 3, lines 58-64). It would have been obvious for one skilled in the art, at the time of the invention to learn from Gennmaro to implement a first program used to modify the printable product. Rhoads discloses using a website and accessing "customizing" information from a server, wherein this information is downloaded to the client and used for customizing the printable product. Such data would include a first program, which represented as an applet would allow the user to manipulate and carry out the functions needed to customize only when the user has made a request to customize, in reference to the website they have accessed, which allows for mobility. Hence, one skilled in the art, would have been motivated to learn from Gennmaro to specifically indicate that the information accessed from the server to be displayed on a website, include a first program which would be downloaded to the client's computer and used for displaying and customizing the defining functions for a printable product.

Referring to claims 2 and 15, Rhoads and Gennmaro discloses that the plurality of printable products includes greeting cards (Rhoads, column 10, lines 51-53).

Referring to claims 3 and 16, Rhoads and Gennmaro discloses a browser program, as is used for displaying websites, accessing the web server, with the first program, represented as the first program enhancing the functionality of the browser program (Gennmaro, Figure 1, column 3, lines 38-42).

Referring to claims 4 and 17, Rhoads and Gennmaro discloses that product defining data for customizing the product is downloaded to the client from the server, wherein the web applet,

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represented as the first program downloaded, can download the information for customizing the product (Rhoads, column 10, lines 51-56).

Referring to claims 5 and 18, Rhoads and Gennmaro disclose that the defining data for the personalization of the product includes text elements (Rhoads, column 10, lines 18-20).

Referring to claim 14, Rhoads discloses a system for the creation of printable products on-line. The on-line system is represented in an Internet network, which is made of a client and server. Rhoads discloses the online acquisition of a greeting card, which suggests a user through a client accessing information from a website which is presented to the user, the data that is stored in a server. Rhoads discloses presenting to the user, a variety of simple editing tools for customizing the greeting cards, thereby suggesting the server presenting data stored in the server that is data defining a plurality of printable products with design elements for modifying and assembling the product. Rhoads suggests with the website, a user accessing the server with a client for defining the data, wherein accessing the information through the website, suggests downloading the data to the client. Rhoads disclosure of customizing within the website suggests that assembling and modifying, customizing occur with the web browser on the client computer. Rhoads also suggests a printer operatively coupled with a client computer, wherein the printable product customized at a website, can be printed at the user's computer. See column 10, lines 51-56 and lines 24-26. Rhoads, discloses the use of accessing websites to create the customized the printable products, but does not discuss the details of this method, wherein a first program is downloaded to provide users with the modifying data for the printable products, as recited in the claims. Gennmaro discloses another website system with a server and clients, wherein a first program, represented as the applet is downloaded from the server to the client's

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computer, in order to display a menu wherein a user may manipulate or customize the web page based on their desires (column 3, lines 58-64). It would have been obvious for one skilled in the art, at the time of the invention to learn from Gennmaro to implement a first program used to modify the printable product. Rhoads discloses using a website and accessing "customizing" information from a server, wherein this information is downloaded to the client and used for customizing the printable product. Such data would include a first program, which represented as an applet would allow the user to manipulate and carry out the functions needed to customize only when the user has made a request to customize, in reference to the website they have accessed, which allows for mobility. Hence, one skilled in the art, would have been motivated to learn from Gennmaro to specifically indicate that the information accessed from the server to be displayed on a website, include a first program which would be downloaded to the client's computer and used for displaying and customizing the defining functions for a printable product.

Referring to claim 19, Rhoads and Gennmaro that the applet downloaded into the browser enables the building of menus which can be used by Rhoads within the browser to access customization information for customizing printable products for printing (Rhoads, column 10, lines 51-56; Gennmaro, column 3, lines 58-64).

Referring to claims 22 and 23, Rhoads discloses an Internet network system, wherein the user accesses the customization information for greeting cards through a web site. Rhoads, thereby disclosing this online access, suggests the presence of a web server, a client computer, wherein the user can communicate and access information from the web server to display the information. A web browser which allows for the website to be displayed on the client computer. Rhoads suggests with the website, a user accessing the server with a client for

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defining the data, wherein accessing the information through the website, suggests downloading the data to the client. Rhoads disclosure of customizing within the website suggests that assembling and modifying, customizing occur with the web browser on the client computer. Rhoads also suggests a printer operatively coupled with a client computer, wherein the printable product customized at a website, can be printed at the user's computer. See column 10, lines 51-56 and lines 24-26. Rhoads, discloses the use of accessing websites to create the customized the printable products, but does not discuss the details of this method, wherein a plug-in program is downloaded to provide users with the modifying data for the printable products, as recited in the claims. Rhoads also does not explicitly state a database stores the information, which is stored and accessed for customizing the display for customizing the printable product, as, recited in the claims. Gennmaro discloses another website system with a server and clients, wherein a plug-in program, represented as the applet is downloaded from the server to the client's computer, in order to display a menu wherein a user may manipulate or customize the web page based on their desires (column 3, lines 58-64). Gennmaro also discloses a database for storing any information that needs to be accessed by the client from the server, with the database couple to the web server or hosting system (column 3, lines 26-33). It would have been obvious for one skilled in the art, at the time of the invention to learn from Gennmaro to implement a plug-in program used to modify the printable product and database storing the information that is needed. Rhoads discloses using a website and accessing "customizing" information from a server, wherein this information is downloaded to the client and used for customizing the printable product. Such data would include a plug-in program, which represented as an applet would allow the user to manipulate and carry out the functions needed to customize only when the user has made a

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request to customize, in reference to the website they have accessed, which allows for mobility. With specific defining data, there must be some structured storage means which would make it easily accessible to get the defining data, and the host system has disclosed in Gennmaro has such a database which stores any data that is needed for customizing the web page. Hence, one skilled in the art, would have been motivated to learn from Gennmaro to specifically indicate that the information accessed from the server to be displayed on a website, include a plug-in program and defining data stored in a database coupled to the server/host system, which would be downloaded to the client's computer and used for displaying and customizing the defining functions for a printable product.

Referring to claim 24, Rhoads and Gennmaro disclose the storing of data, wherein the storage devices used in their invention including remote storage device, a web server, a personal or client computer and a storage medium, all being needed and are inherently part of an Internet network (column 3, lines 22-32).

Referring to claim 25, Rhoads and Gennmaro disclose a means through which the plug-in program of Gennmaro allow the user to access information from an external source, such as storage devices found in a host system that are not in the client/user's computer, thereby making it external, and this information which are design elements for the web page is created based on actions by the user, wherein a user may make certain choices which would initiate the creation of new web page design elements (Gennmaro, column 3, lines 27-32 and column 4, lines 19-29).

3. Claims 13 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads and U. S. Patent No. 5,552,994 (Cannon et al.).

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Referring to claim 13, Rhoads does not disclose customizing the layout of the printable product, as recited in the claims. Cannon discloses that assembling of printing data also includes division into panels for anticipating printing in a desired format (column 12, lines 3-5). It would have been obvious for one skilled in the art, at the time of the invention to learn from Cannon for methods for explicitly stating printing formats for the printable products. Rhoads does customize and print a product based on the needs of a user, since printing is involved, there must be some specific formatting means, which would allow the users to choose the layout they desire before printing. Cannon is a product customizing system, which allows for customizing and printing much like Rhoads. Hence, one skilled in the art would have been motivated to learn from Cannon to implement specific formatting layout means for printing.

Referring to claim 26, Rhoads discloses the storing of data, wherein the storage devices used in their invention including remote storage device, a personal or client computer and a storage medium, all being needed and are inherently part of an Internet network. But Rhoads does not disclose a portable storage medium, as recited in the claims. Cannon discloses a portable storage medium, represented as the CD of Figure 3 (reference number 33). It would have been obvious for one skilled in the art, at the time of the invention to learn from Cannon to implement a portable storage medium. It is well known that CDs are used for accessing information; wherein data this is stored can be accessed, while also giving mobility to the information, wherein the medium is portable. Portability gives much more flexibility, allowing the users to do much more with data that can be used in various computers without relying on a network. Hence, one skilled in the art would have been motivated to learn from Cannon and implement a portable storage medium.

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4. Claims 8-9 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads and Gennmaro, and further in view of Cannon.

Referring to claims 8 and 20, Rhoads and Gennmaro do not disclose customizing the layout of the printable product, as recited in the claims. Cannon discloses that assembling of printing data also includes division into panels for anticipating printing in a desired format (column 12, lines 3-5). It would have been obvious for one skilled in the art, at the time of the invention to learn from Cannon for methods for explicitly stating printing formats for the printable products. Rhoads and Gennmaro do customize and print a product based on the needs of a user, since printing is involved, there must be some specific formatting means, which would allow the users to choose the layout they desire before printing. Cannon is a product customizing system, which allows for customizing and printing much like Rhoads and Gennmaro. Hence, one skilled in the art would have been motivated to learn from Cannon to implement specific formatting layout means for printing.

Referring to claims 9 and 21, Rhoads and Gennmaro do not disclose the specifics of how the printable product is customized or modified, as recited in the claims. Cannon discloses that modification includes modifying font, color and position within a panel (column 11, lines 50-60). It would have been obvious for one skilled in the art, at the time of the invention to learn from Cannon for methods for the specifics of customizing the printable products. Rhoads and Gennmaro do customize and print a product based on the needs of a user, and since there is customization, it is inherent that some specific actions would be taken by the users to customize the printable product. Cannon is a product customizing system, which allows for customizing and printing much like Rhoads and Gennmaro, but additionally discusses the specific means

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through which a user can customize the product. Hence, one skilled in the art would have been motivated to learn from Cannon to implement specific formatting means for customizing the printable product.

Response to Claim Changes

5. The Examiner acknowledges the Applicant's amendments narrowing the scope of claims 1, 10, 13, 14 and the addition of claims 22-26. Limitations have been added to the independent claims 1, 10, 13 and 14 to further define the invention specifically and further limit. However, the amended claims are still rejected under 35 USC § 102 and 103 as being obvious over Rhoads, Gennmaro and Cannon.

Response to Arguments

6. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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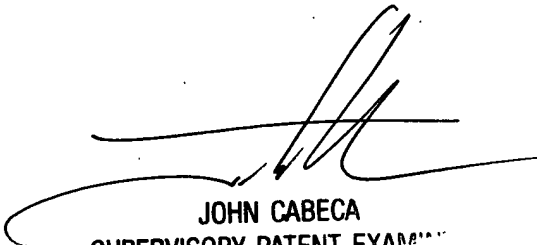
however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namitha Pillai whose telephone number is (703) 305-7691. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (703) 308-3116. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7238 for regular communications and (703) 746-7240 for After Final Communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Namitha Pillai
Assistant Examiner
Art Unit 2173
June 30, 2003



JOHN CABECA
SUPERVISORY PATENT EXAMINER
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